defective His-Asp phosphorelay pathway." Based on this assertion, the Examiner then further asserts that the skilled artisan can conclude that the cells of Williamson and Tomasz have a defect in their His-Asp phosphorelay pathway. The Examiner concludes by stating that the U.S. Patent Office does not have the facilities for examining and comparing the cells being claimed with those of Williamson and Tomasz and therefore must assume that they are the same.

The Applicants respectfully traverse the Examiner's rejections. As indicated in our prior Response, and contrary to the Examiner's assertion, Novak *et al.* (1999) do not state that all vancomycin tolerant *Streptococcus pneumoniae* have a defective His-Asp phosphorelay pathway. Rather, Novak *et al.* (1999) simply demonstrated that having a defective His-Asp phosphorelay pathway leads to vancomycin tolerance. Indeed, Charpentier *et al.*, *Mol. Microbiol.* **37(4)**:717-726 (2000) [Exhibit 1] have demonstrated that *Streptococcus pneumoniae* having a defective ClpC ATPase are vancomycin tolerant even though they do not have a defect in their His-Asp phosphorelay pathway (*see* Charpentier *et al.*, Page 720, column 2, first full paragraph, bottom two lines). ClpC ATPase is believed to be a chaperone-regulator of proteolysis and a heat-shock protein. Therefore, whereas mutant *Streptococcus pneumoniae* having a defective His-Asp phosphorelay pathway are vancomycin tolerant, all vancomycin tolerant *Streptococcus pneumoniae* do not have a defective His-Asp phosphorelay pathway. Thus, whereas the present invention provides methods of using cells that specifically have a defective His-Asp phosphorelay pathway, Williamson and Tomasz only provide cells that are vancomycin tolerant. Indeed, Williamson and Tomasz made no effort to determine the genotypes of their cells. Since vancomycin tolerance phenotype can be due to any of a number of factors (including a defective ClpC ATPase described above) the skilled artisan could not assume that all (if any) of the cells of Williamson and Tomasz have a defective His-Asp phosphorelay pathway.

The Federal Circuit has held that:,

"[t]o anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject-matter."*PPG Industries, Inc. v. Guardian Industries Corp.*, 37 USPQ2d 1618 (Fed. Cir. 1996).

In the present case, Williamson and Tomasz have not provided the requisite cells with the specific genotype for performing the claimed methods. Indeed, whereas Williamson and Tomasz isolated cells based on a particular phenotype, the cells of the present invention are selected for a specific genotype. For the reasons stated above, these two different means of selection are clearly not equivalent. Therefore, Williamson and Tomasz cannot anticipate the invention as claimed.

In view of the above and foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 (b) are respectfully solicited.

From the above and foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

No fees are believed to be necessitated by the foregoing amendments. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,
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